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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,545	12/11/2003	Michael B. Letchworth	1388-029/63332	2681

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EXAMINER	
MEHTA, ASHWIN D	

ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/735,545	LETCHWORTH, MICHAEL B.	
	Examiner	Art Unit	
	Ashwin Mehta	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3302004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are broadly drawn towards any hybrid corn seed produced by crossing an inbred corn plant of line "MN7224" with any different corn plant; or a hybrid corn plant, or parts thereof, produced by growing said hybrid seed.

The specification provides some morphological and physiological characteristics of plants of inbred corn line "MN7224" (Table 1, pages 12-13)).

A review of the full content of the specification indicates that seed of corn plant MN7224, hybrid seed produced by crossing a MN7224 plant with any other corn plant, are essential to the operation and function of the claimed invention.

A review of the language of claims 9 and 10 indicates that they are drawn to a broad genus, i.e., any and all F1 hybrid corn seeds, and the hybrid corn plants produced by growing said hybrid seeds, wherein the hybrid seeds are produced by crossing corn plant MN7224 with a

second, distinct inbred corn plant. Variation is expected in the complete genomes and phenotypes of the different F1 hybrid species of the genus, since each hybrid has one non-MN7224 parent that is not shared with the other hybrids. Each of the hybrids would inherit a different set of alleles from the non-MN7224 parent. As a result, the complete genomic structure of each hybrid, and therefore the morphological and physiological characteristics expressed by each hybrid, would differ. Any given specie of the claimed genus would not be representative of any other specie. Given the breadth of the claims encompassing all hybrid corn seeds and plants produced by crossing MN7224 to any other corn plant, it is submitted that the specification fails to provide an adequate written description of the multitude of corn seeds and plants encompassed by the claims.

2. Claims 1-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 is drawn towards seed of corn inbred line MN7224, representative seed having been deposited under ATCC Accession No. PTA-5448. Claims 2-33, are drawn towards a corn plant produced by growing said seed, methods comprising inbred corn plant MN7224, and products produced from the methods.

Page 36 of the specification indicates that seeds of inbred corn line MN7224 were deposited with the ATCC on September 3, 2003, and that the deposit is intended to meet all of the requirements of 37 CFR 1.801-1.809. However, Applicants have not provided any indication

that a viability test was conducted. See 37 CFR 1.807. Further, paragraph [0159] on page 38 of the specification indicates that the deposit will be maintained for 30 years or 5 years after the last request, or for the "effective" life of the patent, whichever is longer. However, the term, "effective" should be --enforceable--. See 37 CFR 1.806.

Claim Rejections - 35 USC § 102 & 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 9-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marshall et al. (U.S. Patent No. 6,284,955 issued September 4, 2001).

The instant claims are broadly drawn towards any F1 hybrid corn seed produced by crossing a first corn plant with designated "MN7224" with another different corn plant; or a hybrid plant, or parts thereof, produced by growing said hybrid seed.

Marshall et al. teach F1 hybrid corn seeds, and corn plants produced by growing said seed, and parts of said plant (claims). The corn seeds and plants may have been produced from a

method different from those of the instantly claimed corn seeds and plants. However, the instantly claimed products do not appear to differ from the products taught by the reference. The instant claims do not recite any limitation(s), such as expressed traits, that would distinguish the products from those of the reference. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

4. Claims 1-33 are rejected.

Contact Information

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at 571-272-0975. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as

general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

June 12, 2006

Ashwin D. Mehta, Ph.D.
Primary Examiner
Art Unit 1638

ATTACHMENT TO OFFICE ACTION

Request for Information under 37 CFR § 1.105

1. Applicant and the assignee of this application are required under 37 CFR § 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. This request is being made for the following reasons:

Applicant is claiming a seed comprising at least 50% of the genome of corn line MN7224, and corn plants produced in methods that comprise performing crosses with corn plant MN7224. However, the instant specification is silent about what starting materials and methods were used to produce corn line MN7224. The requested information is required to make a meaningful and complete search of the prior art.

3. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

(i) What were (are) the original parental corn lines used to produce corn line MN7224? Please supply all of the designations/denominations used for the original parental corn lines and line MN7224. Please supply information pertaining to the lineage of the original parental lines back to any publicly available varieties.

(ii) What method and method steps were used to produce corn line MN7224?

(iii) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, had any of said parental corn lines or progeny therefrom been disclosed or made publicly available? If so, under what designation/denomination and

under what conditions were said parental corn lines or progeny disclosed or made publicly available and from when to when?

(iv) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, were any other corn lines produced by said method using said original parental corn lines, and if so, had said produced corn lines been publicly available or sold? If so, under what designation/denomination and under what conditions were said other corn lines disclosed or made publicly available and from when to when?

3. If Applicant views any or all of the above requested information as a Trade Secret, then Applicant should follow the guidance of MPEP § 724.02 when submitting the requested information.

4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure. Please indicate where the relevant information can be found.

5. The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

6. The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

7. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER